

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ginsberg et al. Group Art Unit : 3714
Application No. : 09/846,025 Confirmation No. : 4295
Filed : April 30, 2001
Title : REAL-TIME INTERACTIVE WAGERING ON EVENT OUTCOMES
Examiner : Corbett B. Coburn

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the Office Action mailed February 24, 2009. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

ARGUMENTS

Clear Errors in 35 USC 103 Rejection

The Office action rejected claims 11, 13, 15, and 56-65 under 35 U.S.C. § 103(a) as being allegedly unpatentable over portions of U.S. patent No. 5,277,424 to Wilms (hereinafter "Wilms") in combination with an unsupported conclusory statement.

No Evidence Cannot Meet The Substantial Evidence Requirement

United States federal agencies must provide “**substantial evidence**” for factual findings. Specifically, the Federal Circuit has held that obviousness is a legal question based on underlying factual findings that must be supported by **substantial evidence**. See *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001) See also *MPEP* § 2144.03 (“The standard of review applied to findings of fact is the ‘**substantial evidence**’ standard under the Administrative Procedure Act (APA)”). Notably, in *KSR* the Court reiterated that mere conclusory statements are insufficient to base a conclusion of obviousness. *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-42 (S.Ct. 2007). And after *KSR*, the Court has maintained this standard stating that “vague and conclusory” statements are not evidence that can support a finding of fact. See *Innogenetics*, 512 F.3d 1363, 1373-74 (Fed. Cir. 2008).

The Office action makes a conclusory statement that “displaying to said client a list comprising only said selection of wagerable event outcomes” would have been obvious but provides **no evidence at all** to support this conclusory statement.

Although an example of a potential motivation for combining this limitation with the prior art citation is given (again with **no evidence at all** as support for the motivation existing at the time of the filing of the application), the presence of a motivation to combine a limitation with a cited prior art reference is **no evidence at all** that the limitation itself was known or obvious in the prior art. For example, it may be desirable now to have a cold fusion source of energy to reduce the need to burn fossil fuels, but that desire and benefit are not evidence that shows that a cold fusion source of energy exists now.

No evidence at all cannot possibly meet the **substantial evidence** standard, and therefore each and every rejection that relies on this conclusory statement must be withdrawn. All rejections under 35 USC § 103 rely on this conclusory statement provided with **no evidence at all**. Accordingly, withdrawal of all rejections under 35 USC § 103 as improper is requested.

The Office Action Admits That All Limitations Are Not Taught Or Suggested By The Prior Art

In order for a proper rejection to be made under 35 USC 103, the Office action must show that each and every limitation of a claim is taught or suggested by one or more references in the prior art. The Office action admits that the limitation of claim 11, “displaying to said client a list comprising only said selection of wagerable event outcomes,” is not taught by the only cited reference, Wilms, on page 3. The Office action makes no statement that the limitation of “displaying to said client a list comprising only said selection of wagerable event outcomes” is taught or suggested by any cited prior art reference. Accordingly, the Office action fails to properly address each and every limitation of the claims as required for a proper rejection under 35 USC 103. See *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000) (“The examiner has left applicant and the board to guess as to the basis of the rejection and after having us guess would have us figure out (i.e., further guess) what part of which [reference] supports the rejection. We are not good at guessing; hence, we decline to guess.... What we are saying is that the examiner has failed to develop the record sufficiently to permit applicant to address the issues and for us to make a cogent ruling on any difference of opinion between applicant and the examiner.”). Therefore, the rejections under 35 USC 103 of the claims must be withdrawn.

The Office Action Fails To Make A Prima Facie Case For Rejection

According to MPEP 2141, in order to establish a prima facie case that shifts the burden of proof to show obviousness from the Examiner to the Applicant, an Examiner must have **“established the *Graham* factual findings and** concluded that the claimed invention would have been obvious.” As discussed above, the Office action has not established any factual findings regarding the limitation of “displaying to said client a list comprising only said selection of wagerable event outcomes,” present in each claim. Rather, the Office action skipped directly to making conclusory statements of obviousness. Accordingly, no prima facie case of obviousness has been established. No burden shifts to the applicants until the Examiner has addressed every element of a *prima facie* case of unpatentability. See *In re Glaug*, 283 F.3d

1335, 1338, 62 USPQ2d 1151, 1152 (Fed. Cir. 2003) (“During patent examination the PTO bears the initial burden of presenting a prima facie case of unpatentability. If the PTO fails to meet this burden, then the applicant is entitled to the patent.”). So the burden of proof of establishing the conclusion of obviousness based on supported factual findings remains with the Examiner. Therefore, any rejection of the claims must be withdrawn.

CONCLUSION

Because the Examiner failed to provide proper rejections for any of the claims, withdrawal of rejections of these claims and the finality of any Office Actions is requested.

July 24, 2009
Date

Respectfully submitted,
/Mark A. Miller/
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